UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,877	02/10/2004	Todd Simpson	87239/00004	8796

27871 7590 10/23/2008

BLAKE, CASSELS & GRAYDON LLP
BOX 25, COMMERCE COURT WEST
199 BAY STREET, SUITE 2800
TORONTO, ON M5L 1A9
CANADA

EXAMINER	
CHANKONG, DOHM	
ART UNIT	**PAPER NUMBER**
2452	

MAIL DATE	DELIVERY MODE
10/23/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/774,877	**Applicant(s)** SIMPSON, TODD	
	Examiner DOHM CHANKONG	**Art Unit** 2452	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Dohm Chankong/
Examiner, Art Unit 2452

Continuation of 3. NOTE:
Applicant's arguments with respect to the §112, first paragraph rejection have been considered and are persuasive. However, since prosecution of the instant application is closed, the rejection will be withdrawn in either an examiner's answer (if Applicant files an Appeal Brief) or in the next action on the merits (if Applicant files a request for continued examination).

Applicant proposes amending independent claims 14 and 24, to recite, inter alia, that a sender subsystem initiates a categorization negotiation process. Prior to this proposed amendment, absent the new term "categorization" the limitation had been interpreted as referring to a negotation process for delivery and transactions between the sender and receiver. The proposed amendment further limits the claim by specifying that the negotiating process is limited to negotiating categories. Therefore a new issue is raised and this new issue would require further consideration and search. Therefore, the proposed amendment will not be entered .

As to claim 47, Applicant argues that Schiavone does not teach a sender and receiver negotiating categories. The rejection relied upon Schiavone's teaching that the sender and recipient "share knowledge of a common set of message type specifiers." Schiavone's teaching is analogous to Applicant's own teaching that "[i]mplicit on both the sender and receiver sides is a representationof applicable categories." [Applicant's patent application publication 20040199593, 0025]. Schiavone's senders and receivers transmit their preferred specifiers to the trusted intermediary [0055]. The intermediary then forms the common set of rules based on the sender and receiver preferences. The common set of message type specifiers represents the product of the negotiation between the sender and the receiver. In other words, the sender submits specifiers that it prefers, the receiver submits specifiers that it prefers, and then a common set is formed from these preferences. Thus as a result of Schiavone's negotiating process, a sender is limited to which specifier it can select based on what is acceptable to both the sender and the recipient. While not relied upon to teach this feature, Gross also teaches negotiating a category between receiver and sender. For example, Gross discloses a sender proposing possible categories to the recipient whereby the recipient may accept or reject the proposed categories [0263]. Finally, it would be beneficial for Applicant to further define in the claims what is meant by a "negotiation." Applicant argues that Gross is limited to the receiver simply publishing categories that a sender must follow in order to send messages. This is arguably a form of negotiation in the sense of a "take-it or leave-it" tactic. The receiver simply notifies the sender that if the sender wishes to communicate messages to the receiver, the sender must use the published categories. The category has thus been "negotiated" between the two parties with the receiver specifying what is acceptable. Once the sender uses one of the receiver's published categories, the negotiation is completed. Applicant's argument implies a more give-and-take process but this is not the only way to interpret "negotiation." Merriam-webster defines "negotiate" as "to confer with another so as to arrive at the settlement of some matter." http://www.merriam-webster.com/dictionary/negotiate. Both Schiavone and Gross teach this definition.

The rejection did rely on Gross to teach associating a category with a message upon receiving an indication from the receiver that the category is recognized by the receiver. Applicant argues that Gross discloses accepting and rejecting "processing criteria" and not categories. According to Applicant, Gross' tags (categories) are different from processing criteria. However, Gross clearly states that "[t]hese processing criteria are unique TAGS associated with the processing critera" (emphasis added) [0042] and that "[p]rocessing criteria INCLUDE category data" [0053]. The section cited by Applicant states that "the tagged message can addtionally be processed in accordance to OTHER predefined processing criteria" (emphasis added) [0045]. Clearly, Gross views tags as being processing criteria.

Based on the foregoing, Applicant's arguments are not persuasive and the §103 rejections set forth in the previous Office action are maintained.